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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/938,735

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Takashi Saito

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2749

22428

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01/10/2005

FOLEY AND LARDNER

SUITE 500

3000 K STREET NW

WASHINGTON, DC 20007

EXAMINER

PAYNE, DAVID C

ART UNIT

PAPER NUMBER

2633

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,735

Applicant(s)

SAITO, TAKASHI

Examiner

David C. Payne

Art Unit

2633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 30 June 2004 have been fully considered but they are not persuasive.
2. Regarding applicant's traverse of the Kahura patent and specifically that the monitor does not detect optical signals. It is apparent that the applicant has defined the monitor circuit more narrowly, as MP DET, than what was indicated in the previous office action. The Examiner has indicated that the monitor circuit includes the components of PTi in Figure 3. This would include the photodetector (PD), the receiver and the pulse detector, described as follows in Kahura,

Optical signals branched from the optical couplers C1 and C2 are applied via the optical fibers FR1 and FR2 to a common photodetector PD, wherein they are converted to electric signals, which are provided to the common receiving circuit R. The received signal RD' demodulated by the receiving circuit R has the monitor pulses mp1 and mp2 in the low-level period of the frame synchronizing signal SYN as shown in FIG. 4, if the transmitting and receiving systems of the optical couplers C1 and C2 and the optical transceiver PTi are normal
(Kahura - col./line: 4/52-65).

Furthermore, the applicant's own disclosure (Figure 3) illustrates the same components/steps of optical to electrical conversion of an optical signal demodulation and signal processing. Thus the applicant's arguments are not substantiated.

3. Finally, the applicant's traverse of the data signal SD as disclosing applicant's invention with regard to claims 5, 8, 11 and 14. Kahura, col./line: 5/10-15, describes SD as shown in Figure 6, as synchronizing pulses for use in frame synchronization of transmitted data. It is the Examiners' view that data is representative of signaling information as claimed in the aforementioned claims. Furthermore, the function of these bits are

Art Unit: 2633

deemed consistent with the applicant's own disclosure of signaling data, found on page. 13, lines 23-25 of the specification, "... Here, data contents are signaling information (information necessary for data exchange, such as **start**, response, end-of-call, and select signals). Again, applicant's arguments have not been substantiated.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

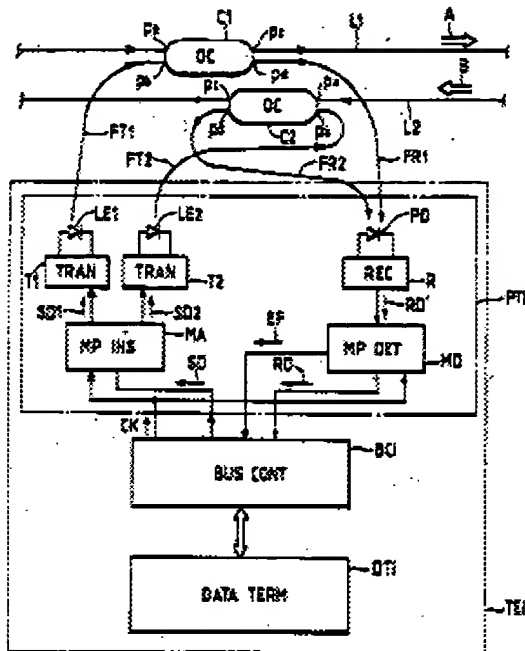
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 5-9, 11, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaharu et al. US 5,130,836 (Kaharu).

Art Unit: 2633

FIG. 3



Re claims 1, 3, 6, 7, 9 and 12 Kaharu disclosed

An optical transmission system (apparatus /monitoring method, external conducting means), comprising an optical communication apparatus, a communicating party of said optical communication apparatus, and a monitor (PTi of Figure 3) for performing monitoring of optical signals transmitted (A of Figure 3) and received (B of Figure 3) between said optical communication apparatus (left of Figure 3) and said communicating party (right of Figure 3); wherein said optical communication apparatus comprises: optical branching means (C1 and C2 of Figure 3) for branching optical signals to be transmitted to said communicating party (left of Figure 3) and optical signals received from said communicating party (left of Figure 3); and conducting means for conducting said optical signals to be transmitted and said received optical signals that have been branched by said optical branching means, to said monitor, and said monitor performs monitoring of the data contents of said optical signals to be transmitted and said

Art Unit: 2633

received optical signals that have been conducted from said conducting means (e.g.,
col./line: 3/50-67).

Re claims 5, 8, 11 and 14 Kaharu disclosed

wherein said data contents are signaling information necessary for data exchange (e.g.,
col./line: 5/10-35).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 4, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaharu et al. US 5,130,836 (Kaharu).

Re claims 2, 4, 10 and 13 Kaharu does not disclose

wherein said monitor consists of two mutually independent monitors: a monitor for performing monitoring of the data contents of said optical signals with separate interfaces.

However, it would have been obvious to one of ordinary skill in the art at the time of invention to use separate monitors if for example monitoring occurred in separate

Art Unit: 2633

locations or by different operators. Furthermore, making parts separable is not patentable over the prior art.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Payne whose telephone number is (571) 272-3024. The examiner can normally be reached on M-F, 7a-4p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on (571) 272-3022. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2633

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dcp



**HANH PHAN
PRIMARY EXAMINER**